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APR 24 2008

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robertson, S. Examiner: Rosen, N.
Serial No.: 10/634,627 Group Art Unit: 3625
Filing Date: 08/05/2003 Attorney Docket: ROBERT.P002D1
Title of Invention: System and Method for Providing Electronic Multi-Merchant Gift Registry Services Over a Distributed Network

Seattle, Washington 98109
April 24, 2008

Mail Stop - Petition
TO THE COMMISSIONER OF PATENTS
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REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.181

Applicant acknowledges receipt of a response mailed Feb. 19, 2008 to Applicant's Request for Reconsideration of Petition Under 37 CFR 1.181 filed on Dec. 26, 2007, in which the petition was denied. Applicant hereby respectfully requests reconsideration of the original petition under 37 CFR 1.181 filed Aug. 16, 2007 and consideration of the further facts presented in this current request for reconsideration. It is the purpose of the Petition Under 37 CFR 1.181 filed on Aug. 16, 2007 and the subsequent request for reconsideration filings to obtain from the Director his specific ruling as to whether the use of "official notice" in this case is in compliance with the rules of the MPEP or not. In none of the responses from the Director has this issue been addressed. Procedural impropriety is not an appealable matter. The Director will appreciate that Applicant is concerned that the true issue being petitioned (and thereby Applicant's just patent rights) not be lost between the substantive issues being considered by the Board of Patent Appeals and

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April 24, 2008


Patrick Dwyer

1-800-771-1000

Interferences, and the procedural matters that are rightly the jurisdiction of the Director to oversee, namely the assurance of procedurally correct examination.

In the response of Feb. 19, 2008, the Director has objected to language in both petitions directed to seeking the remedy of setting aside every part of the rejections that are based upon the improper use of "official notice". The Director has explained that the setting aside of rejections by petition is not an available remedy to a procedural impropriety. Alright. Applicant hereby retracts the request of this specific remedy and hereby asks the Director to apply such remedy as the Director thinks appropriate in this situation where an Examiner has committed procedural impropriety in the examination.

Applicant further wishes to make clear that Applicant did not intend, nor request, the Director to consider the merits of the claims. Applicant is petitioning to redress improper Examiner procedure under the rules of the MPEP, which procedural error Applicant believes is not appealable.

In addition, at the time of this request for reconsideration, the Examiner is claiming that Applicant did not traverse the Examiner's taking of official notice and that the traversal of the Examiner's taking of official notice was untimely. This is blatantly not true, and Applicant respectfully requests the Director to consider the facts presented in this petition which address this assertion by the Examiner. Following are quotes from the Remarks section of Applicant's Amendment and Response to the Examiner's Office Action filed 12/20/2006:

"Claims 29, 30 and 32 are rejected under 35 U.S.C. 103 (a) as allegedly unpatentable over the article "Going to the Chapel" by Cohen in view of official notice; Applicant respectfully traverses this rejection. The Examiner admits that Cohen does not expressly disclose element (a) of base Claim 29, "running a gift registrar application on at least one gift registry site". The Examiner then asserts an unsupported 'official notice' that "running applications on computers is well

known." But there is no suggestion in Cohen that his "gift registry" or "bridal registry" is anything more than a displayed table; not the gift registrar application as disclosed by Applicant." (Applicant's Amendment and Response filed 12/20/2006, Page 10, Paragraph 3)

"Independent claims 46 and 47 each contain the same elements from Claim 29 that have been discussed in light of Cohen: element (a) "running a gift registrar application on at least one gift registry site", and element (b) "a gift registrant accessing goods or services online from a goods or service provider (SP) Site" (element (b) in Claim 46 differs from Claim 29 only in that a single Service Provider is claimed rather than a plurality of Service Providers). Neither of these elements is disclosed or even suggested by Cohen as discussed above. While, as a courtesy the above arguments will not be repeated here, Applicant believes that since these elements are not taught by Cohen, nor Shilcrat and since no further support has been given for the Examiner's 'official notice' in the rejections of Claims 46 and 47, the claims are allowable and early favorable action is requested." (Applicant's Amendment and Response filed 12/20/2006, Page 13, Paragraph 2)

Applicant believes that the above language makes the Applicant's traversal of the Examiner's taking of "official notice" perfectly plain. Any other interpretation is a blatant attempt to circumvent a procedurally correct examination, which is a duty owed by the PTO to every applicant. If the public already owns the invention, then it should be established by evidence, and not by opinion, and the claims rejected. Rejections cannot be made to depend on playing "gotcha" games with the rules of the MPEP as a substitute for the finding of legitimate prior art citations. Applicant is forced to wonder how often examiners take this course and, perhaps inadvertently, circumvent a procedurally correct examination. Why should the Examiner

insist on a misinterpretation of the Applicant's traversal of "official notice" and request for proper prior art citation? Surely, it would be simpler to produce the prior art that supports what is so "capable of instant and unquestionable demonstration as being well-known" (quoting the MPEP rule the Examiner is using) than to prompt appeal, petition and further action. Applicant can only assume there are no such references and it is the Examiner's intention to do Applicant out of his just patent rights, based solely on a misinterpretation of the language of Applicant's response, all shoe horned into a technicality of rule.

Applicant also points out that all other claim rejections depended from one of the above claim rejections where the taking of "official notice" was traversed. Claim 31 (Examiner's Office Action dated 7/20/2006, Page 5), 39 (Page 8), 42 (Page 9), 43 (Page 10), 44 and 45 (Page 10) were rejected with "official notice as applied to claim 29 above". Claim 33 (Page 6), was rejected with "official notice as applied to claim 32 above". Claim 34, 35, 36, 37 (Page 6), were rejected with "official notice as applied to claim 33 above" which depended on the official notice given to 32 above. Claims 40 and 41 (Page 9) were rejected with "official notice as applied to claim 39 above" which depended on the official notice given rejecting 29 above. Hence, every claim rejection depends solely upon missing elements of the independent claims being supplied by the imagination of the Examiner under the pseudonym of "official notice", which was clearly traversed in Applicant's Amendment and Response filed 12/20/2006.

For the Director's convenience, in the following paragraphs, Applicant includes the substance of the Petition Under 37 CFR 1.181 filed on Aug. 16, 2007 with any reference to which remedy is sought amended.

In a final action dated January 31, 2007, the Examiner has inappropriately used "official notice" in lieu of appropriate prior art citations. Section 2144.03 (A) of the MPEP states:

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not

capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.”

Regarding rejections of base independent Claims 29, 32, 46 and 47, a brief article written by Cohen is the only reference the Examiner has cited against Claims 29, 46 and 47. The Examiner admits that “Cohen does not expressly disclose (a) running a gift registrar application on at least one gift registry site,” then proceeds to state, “...but official notice is taken that running applications on computers is well known”! (Even at this stage, the Examiner chooses to truncate and reduce to absurdity the full extent of the limitation he is “officially” noticing.) The claim actually requires “running a gift registrar application on at least one gift registry site.” Even assuring that this full limitation is what the Examiner intended to “officially” notice, for the Examiner to claim that “running a gift registrar application on at least one gift registry site” is a, “fact asserted to be well knowncapable of instant and unquestionable demonstration as being well known,” is clearly not supportable, for there is no evidence that, at the time of the invention, running a gift registrar application on a gift registry site was known at all, much less well known. Furthermore, the claim actually requires that the gift registrar application perform the steps of storing a wish list of gift selections made by a registrant at a plurality of service provider sites and returning that list to a purchaser remote from any gift registry site. These further limitations, which according to Applicant’s claims are performed by the gift registrar application, are not addressed at all. Clearly the gift registrar application required is not such an application as is “capable of instant and unquestionable demonstration as being well known”.

In addition, the Examiner admits that “Cohen does not expressly disclose that the gift purchaser accesses the stored wish list from a site remote from any gift registry sites,” then proceeds to state, “...but official notice is taken that it is well known to access online web sites

from remote sites.” Again, the requirement of this claim element in Claims 29, 46 and 47, in combination with a gift registrar application, is certainly not a “fact asserted to be well knowncapable of instant and unquestionable demonstration as being well known.” It is not according to the procedures of Section 2144.03 (A) of the MPEP to use “official notice” to fill in wherever there is a missing claim element in the references cited against complex computer software method claims. The Examiner not only has used an impermissible hindsight reconstruction in making a 103 (a) obviousness rejection, but has provided no combination of references which can be addressed by Applicant for proper argument against the reconstruction when requested by Applicant that he do so. Applicant is expected to accept that the knowledge allegedly in the Examiner’s head is sufficient to replace elements missing in Cohen, the only cited reference.

Further, the Examiner consistently uses the language, “...official notice is taken that it is well known,” when referring to the facts established by his “official notice”. Applicant is left to question whether the Examiner is confused about when the facts he claims are “capable of instant and unquestionable demonstration as being well known” should have been so. To qualify as facts appropriate to “official notice”, they must have been well known, not on July 20, 2006, the date of the first office action, nor on January 31, 2007, the date of the final office action, but on May 7, 1999 the effective filing date of the parent application. The Examiner did not state, “...but official notice is taken that [fact in question] was well known on May 7, 1999,” nor could he (because they were not in 1999 known at all, much less well known.) As provided in MPEP, Section 2144.03 (A), *in re Eynde* (CCPA 1973), the court stated:

“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice”.

Whatever his background, the procedures required by the MPEP, Section 2144.03 (A) do not support that the Examiner is qualified to assert the state of the prior art in 1999 without cited references to corroborate his assertions.

Claims 29, 46 and 47 are the independent claims in the application and are the base claims for all dependent claims. Hence, the Examiner incorporates "official notice as applied to claim 29 above" in his rejection of Claims 30, 31, 33, 34, 35, 36, 37, 39, 40, 41, 42, 43, 44 and 45. Applicant respectfully requests the Director to apply the same remedy to these dependent claims as to the independent claims improperly rejected under "official notice" in all these cases.

Similarly, and further, the Examiner uses official notice to provide a missing claim element in his rejection of Claim 36 on page 6 of the final action dated January 31, 2007. The Examiner admits that "neither Cohen nor 'Lillian Vernon' expressly discloses associating an SP (merchant) site to the occasion reminder," and then continues, "...but official notice is taken that it is well known for e-mails to include merchant or other site links associated to them." Again, the Examiner seems confused as to the time period he must be establishing for the missing element and the missing element is not (at the time of the invention) a "fact asserted to be well knowncapable of instant and unquestionable demonstration as being well known."

Again, in his rejection of Claims 40 and 41 on page 8 of the final action dated January 31, 2007, the Examiner admits that none of the cited references explicitly teaches the gift registrar application displaying a sale event data to users accessing the gift registry site, and the gift registrar application sending a sale event notification, then the Examiner continues, "...but official notice is taken that it is well known to send out notifications (e.g., e-mails) containing advertising." Again, the Examiner seems confused as to the time period he must be establishing for the missing element and the missing element is not a "fact asserted to be well knowncapable of instant and unquestionable demonstration as being well known."

A copy of the claims as currently on appeal before the BPAI were included as Appendix I to the Petition Under 37 CFR 1.181 filed on Aug. 16, 2007. A copy of the final action dated January 31, 2007 was also included (as Appendix II) to Petition Under 37 CFR 1.181 filed on Aug. 16, 2007 with the instances of "official notice" highlighted.

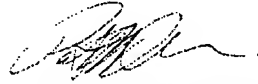
Applicant believes that a proper basis has been established for the Director to rule on the Examiner's misuse of "official notice" in the rejection of Claims 29-37 and 39-47. In specific, for the Director to rule that the Examiner has inappropriately used "official notice" in lieu of appropriate prior art citations.

It is the purpose of the Petition Under 37 CFR 1.181 filed on Aug. 16, 2007, and the subsequently filed requests for reconsideration of this petition, to obtain from the Director his specific ruling as to whether the use of "official notice" in this case is in compliance with the rules of the MPEP or not. Applicant does not intend to limit the range of remedies the Director deems appropriate at this point in this case, and no argument is directed to the merits of the claims in this petition.

Since it appears the Board of Patent Appeals and Interferences is not allowed to rule upon the proper or improper procedural usage of "official notice" by this Examiner, a petition under 37 CFR 1.181 is the only avenue open to Applicant to obtain redress for the improper procedural conduct in this case. Applicant, therefore, requests that the Director reconsider and thoroughly review Applicant's petition under 37 CFR 1.181 filed Aug. 16, 2007, and rule that the Examiner's use of "official notice" in lieu of prior art citation in this case is improper. At that point, an appropriate remedy for such a procedural impropriety is requested from the Director. Without intending either to usurp, or limit, the Director's range of available remedies, Applicant suggests that the Director may think it appropriate to require the Examiner to reconsider and reissue his action, this time including citations to support his opinions.

If the Director believes it might be helpful, Applicant requests a call to Patrick Dwyer at
(206) 550-4049.

Very truly yours,



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P002D1-2ndReqForReconOf1181Per.wpd

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